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10/733,529	12/11/2003	Eric Goldstein	1654-008P/FS3	9051
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SCHWEITZER CORNMAN GROSS & BONDELL LLP 292 MADISON AVENUE - 19th FLOOR NEW YORK, NY 10017			EXAMINER CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,529

Applicant(s)

GOLDSTEIN ET AL.

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 6) <input type="checkbox"/> Other: ____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/24/2004, 7/29/2004, 7/7/2005, 3/10/2006.

DETAILED ACTION

- 1> Claims 1-12 are presented for examination.
- 2> This Office action is a non-final rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 3> Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-6 and 13-19 of U.S. Patent No. 7216290 ['290 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application contain merely obvious variations of the claims of the '290 patent.

For example, claim 2 of the '290 patent recites functionality for displaying a web page with content items, selecting content items, displaying the selected content items exclusive of non-selected content items, loading selected content items within a first frame of a browser window, and a frame division icon operable to divide the first frame into first and second sub-frames.

The only limitation of claim 1 of the instant application that is not disclosed in the claims of the '290 is that the second sub-frame is used for text input; however this minor difference is merely an obvious variation and an intended use for the sub-frame. Since the claims recite similar structures (a first frame divided into a first and second sub-frame where selected content is displayed in the first subframe and the second subframe is empty), it would have been obvious to one of ordinary skill in the art to have used the second subframe to display additional data such as text entry by the user.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4> Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 8 lacks proper antecedent basis: "said second of said independent browser window."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5> Claims 7-12 are rejected under 35 U.S.C §103(a) as being unpatentable over Watanabe et al, U.S Patent Publication No. 2003|008100 [“Watanabe”].

6> As to claim 7, Watanabe discloses a method of selecting and displaying content items in a network browser application on a user computing device, the method comprising:

display programming being operable to create an independent browser window

[Figure 10];

said display programming displaying a text entry icon associated with said

independent browser window [Figure 10 : “New” button | 0051];

upon selection of said text entry icon, said display programming being operable to

receive user text input from said user computing device and to display said user text input

within said independent browser window [Figure 10 | 0053].

7> As to claim 8, Watanabe discloses said display programming inserting said user text input into a source code for said second of said independent browser window [0055-0056].

8> As to claim 9, Watanabe discloses the method further comprising:

programming of said user computer device storing a definition of said independent browser window [Figure 6 | Figure 8 «item s830» where : the annotations embedded with the web content is analogous to the claimed “definition”];

said definition including said user text input [Figure 8 | 0056 where : the annotation data represents the user’s text input];

retrieval programming of said user computing device retrieving a list of stored definitions from memory of a computing device [Figure 11 | 0058, 0059 where : the annotations embedded in the web page are analogous to a list of stored definitions], displaying said list of stored definitions [Figure 11], and receiving a selection of said definition of said independent browser window from said user [0059];

said display programming displaying said user text input according to said definition of said independent browser window [Figure 11 : annotation information].

9> As to claim 10, Watanabe discloses in response to a command from a user, said display programming maintaining said independent window as a top browser window on said computing device [0058 where : the annotation windows are controllable by operating a mouse. It is well known in the art that operating a window with a mouse maintains the window as the top browser window].

10> As to claim 11, Watanabe discloses the method further comprising:

transmission programming transmitting a definition of said independent browser window to a recipient computing device, said definition including said user text input [Figure 8 | 0056 where : the annotation data represents the user's text input];

recipient display programming of a browser application of said recipient computing device displaying said user text input in a recipient browser window according to said definition [Figure 11 : displaying the annotation information based on the embedded instructions].

11> As to claim 12, Watanabe discloses the method further comprising:

transmission programming transmitting a definition of said independent browser window to a second recipient computing device, said definition including said user text input [Figure 8 | 0056 where : the annotation data represents the user's text input. The annotation data and web page are transmitted to client terminals 30a, 30b];

recipient display programming of a browser application of said second recipient computing device displaying said user text input in a recipient browser window according to said definition [Figure 11 : displaying the annotation information based on the embedded instructions. The annotation data is displayed on client terminals 30a, 30b].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

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are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12> Claims 1 and 4-6 are rejected under 35 U.S.C §103(a) as being unpatentable over Rivette et al, U.S Patent No. 6,877,137 ["Rivette"] in view of Cecco et al, U.S Patent No. 6,310,631 ["Cecco"], in further view of Van Der Meer, U.S Patent No. 6,289,362 ["Van Der Meer"].

13> As to claim 1, Rivette discloses a method of selecting and displaying content items in a network browser application on a user computing device, the method comprising:

display programming of said user computing device displaying a network source with

a

plurality of displayed content items in an original browser window, each displayed content item having a network location [Figure 23 «item 1208»];

selection programming receiving a selection of selected content item, from among said plurality of displayed content items [column 23 «lines 1-12»];

display programming of said user computing device with an independent browser window [Figure 23 «items 1212, 1214»];

said display programming displaying a text entry icon associated with a second one of said two subframes [Figure 23 | column 21 «lines 52-53»];

upon selection of said text entry icon, said display programming being operable to receive user text input from said user computing device and to display said user text input

within said second of said two sub-frames [Figure 23 «item 1214» | column 37 «line 57» to column 38 «line 14» where : Rivette's notes area analogous to a user text input].

Rivette does not expressly disclose (1) display programming of said user computing device displaying said selected content item in an independent browser window exclusive of non-selected ones of said plurality of displayed content items, (2) said display programming displaying a frame division icon or (3) loading said selected content item into said independent browser window from said network location.

14> With respect to (1) and (3), Rivette does disclose displaying certain items within a browser window that is independent from the original browser window [Figure 23 «items 1208, 1212»] and alludes to presenting the “selected portion” of a web page [column 5 «lines 1-9»]. However Rivette does not expressly disclose displaying the selected content item or loading the selected content item into the independent window from said network location. Van Der Meer discloses an invention that enables users to select content items from disparate web sources and to display the selected content items in an independent browser window exclusive of non-selected content items [Figures 5 and 9 | column 9 «lines 10-26»]. Van Der Meer also discloses loading the selected content item into said independent browser window from said network location [column 9 «lines 34-57»].

It would have been obvious to one of ordinary skill in the art to incorporate Van Der Meer's teachings into Rivette and modify Rivette's frames to include displaying the selected items exclusive from the non-selected items. One would have been motivated to provide

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such a modification into Rivette in order to provide a catalog display for only those content items selected by the user [see Van Der Meer, column 3 «lines 4-9»].

15> With respect to (2), it should be noted that Rivette does disclose creating multiple sub-frames and displaying content and user text input within the subframes. Rivette however is silent as to the creation of these subframes through the use of a frame division icon. However, Cecco remedies this deficiency and expressly discloses that icons can be used to create new subframes [column 2 «lines 42-46»]. It would have been obvious to one of ordinary skill in the art to have reasonably inferred the use of a frame division icon to create the frames already displayed by Rivette as Cecco discloses that the use of icons to create new subframes for use in an interface is well known in the art.

16> As to claim 4, Rivette as modified discloses said selection programming receives an input of keywords from said user, said keywords being associated with said independent browser window, and further comprising search programming of said user computing device querying a network search engine, said query including said keywords and at least one word from said user text input, and said search programming retrieving said keywords and said user text input from memory of a computing device [Figure 13 «items 1302, 1304» | column 29 «lines 6-24» where : a user can search both the internet and the notes database containing the notes (user text input)].

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17> As to claim 5, Rivette as modified discloses in response to command from said user, said display programming maintaining said window as a top browser window on said computing device [column 26 «lines 58-67» where : the annotation windows are controllable by operating a mouse. It is well known in the art that operating a window with a mouse maintains the window as the top browser window].

18> As to claim 6, Rivette as modified discloses the method further comprising:
transmission programming transmitting a definition of said independent browser window to a recipient computing device, said definition including said network location of said selected content item, said user text input and code defining said first and second sub-frames [column 36 «lines 56-67»];

recipient display programming of a browser application of said recipient computing device displaying said selected content item and said user text input in a recipient browser window according to said definition [column 37 «lines 9-22»]; and

said recipient display programming retrieving said network location of said selected content item from memory of a computing device and loading said selected content item from said network location [column 5 «lines 1-9»].

19> Claims 2 and 3 are rejected under 35 U.S.C §103(a) as being unpatentable over Rivette, Cecco and Van Der Meer, in further view of Watanabe.

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20> As to claim 2, Rivette does not expressly disclose inserting user text input into a source code for said second of said two sub-frames. Watanabe discloses said display programming inserting said user text input into a source code for said second of said independent browser window [0055-0056]. It would have been obvious to one of ordinary skill in the art to have incorporated Watanabe's teachings into Rivette to include the insertion of the text input into source code. One would have been motivated to provide such a modification to Rivette's system in order to accurately reproduce the annotated information within the source document.

21> As to claim 3, Rivette as modified discloses the method further comprising:
programming of said user computer device storing a definition of said independent browser window [column 36 «lines 56-67»];

said definition including said network location of said selected content item [column 5 «lines 1-9»], said user text input and code defining of said first and second sub-frames [column 36 «lines 56-67»];

retrieval programming of said user computing device retrieving a list of stored definitions from memory of a computing device [column 37 «lines 1-3»], displaying said list of stored definitions [column 37 «lines 1-3»] and receiving a selection of said definition of said independent browser window from said user [column 37 «lines 3-13»]; and

said display programming receiving said network location of said selected content item from retrieval programming and displaying said selected content item in a first frame

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and displaying said user text input in a second frame according to said definition of said independent browser window [Figure 23 | column 5 «lines 1-9» | column 37 «lines 14-22»].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Simonoff, U.S Patent No. 6.463.460;

Lal, U.S Patent Publication No. 2003|0048286;

Sidana, U.S Patent No. 6.571.295;

Kasriel, U.S Patent Publication No. 2003|0204490;

Eintracht et al, U.S Patent No. 6.687.878;

Barberis, U.S Patent Publication No. 2004|0021686;

Jakobson, U.S Patent No. 6.697.838;

Stolze, U.S Patent Publication No. 2004|0138946;

Thames et al, U.S Patent Publication No. 2004|0186817;

Lerner et al, U.S Patent No. 6.859.909;

Bargerion et al, U.S Patent No. 7.243.301.

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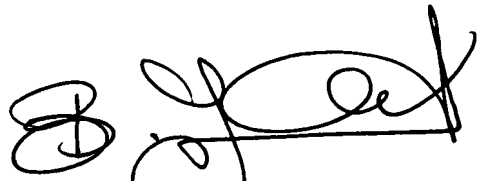
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC


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SUPERVISORY PATENT EXAMINER
8/19/17